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Date of Mailing : June 19, 2008 By: Michelle Whittington
Michelle Whittington

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **LEE**

Atty. Docket No: **IT-03-006**

Appln. No.: **10/696,148**

Group Art Unit: **2151**

Filed: **10/29/2003**

Examiner: **WALSH, JOHN B.**

Title: **ENDPOINT STATUS NOTIFICATION SYSTEM**

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

BRIEF ON APPEAL

Pursuant to Appellant's Notice of Appeal filed on March 19, 2008, Appellant presents this Brief in appeal of the Final Rejection dated September 19, 2007.

I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Inter-Tel, Inc., by way of an Assignment recorded in the U.S. Patent and Trademark Office at reel 014649, frame 0243. However, on June 28, 2006, Inter-Tel, Inc. reincorporated from Arizona to Delaware and

changed its corporate name to Inter-Tel (Delaware), Inc. On August 16, 2007, Inter-Tel (Delaware), Inc. and Mitel Networks Corp. merged and the resulting parent company is Mitel Networks Corp. having a principal place of business at 350 Legget Drive, Kanata, Ontario, Canada K2K 2W7. Thus, to the extent the assignee and the parent companies are the real parties in interest, then Inter-Tel, Inc. as assignee and Mitel Networks Corp. as parent.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the instant application.

III. STATUS OF CLAIMS

Claims 1-18 have at one time, been pending in the present application. Claims 3 and 10 were cancelled. Thus, claims 1, 2, 4-9 and 11-18 remain pending and stand finally rejected. Claims **Appendix A** containing a copy of the claims subject to this appeal is attached.

IV. STATUS OF AMENDMENTS

By Action dated September 19, 2007, the Examiner finally rejected all claims pending under 35 USC §102 as being anticipated by Appelman (US 2004/0196963) and Mullaly (US Patent No. 6,553,341). A Response to the final Action was filed on January 11, 2008. Applicant presented arguments that (1) the Declarations of sole inventor, Lee, under 37 CFR 1.131 filed February 9, 2007 and June 5, 2007 properly swears behind the Appelman reference, and (2) Mullaly fails to teach and every element of Applicant's claims and thus does not anticipate. By

Advisory Action dated March 18, 2008, the Examiner stated Applicant's reply has overcome the rejections in view of Appelman but that *"the applicant's arguments are not entirely persuasive to overcome the rejection in view of Mullaly..."*.

No claim amendments have been submitted after the Final Response or Notice of Appeal.

V. SUMMARY OF CLAIMED SUBJECT MATTER

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal (Claims 1, 9 and 14) is provided.

The subject matter of Claim 1 is directed towards an endpoint status notification system for use in a telecommunications network. The system comprises an address book comprising a plurality of network user's names and their associated endpoints (*see e.g.*, Par. [0034] and FIG. 2). The system further comprises a personal list of contacts comprising the users selected from the address book by one of the users (*see e.g.*, Par. [0036], [0037] and FIG. 2). An instant message alert is received by the user upon every occurrence of a reportable event for the contacts on the list (*see e.g.*, Par. [0038]-[0044] and FIG. 2). The alert comprises one of a plurality of viewable informational status messages pertaining to the contact and is delivered to the user unbeknownst to the contact (*see e.g.*, Par. [0038], [0047] and FIG. 2). The reportable event being selected by the one user for each of the contacts on the list, whereby the reportable events received by the one user may differ for each of the contacts on the personal list (*see e.g.*, Par. [0040], [0043], (202) of FIG. 2, (300) of FIG. 3, [0058]-[0059] and FIG. 6). A viewable call-

control option is received by the one user simultaneous with the instant message alert and selection of the option causes a telecommunication function related to the reportable event and pertaining to the contact to immediately occur (*see e.g.*, Par. [0061]-[0065] and FIG. 7; [0047]-[0054] and FIGs. 5A-5H).

The subject matter of Independent Claim 9 is directed towards a method for endpoint status notification in a telecommunications network having a plurality of users. A list of personal contacts is selected from an address book comprising names and endpoints belonging to the users (*see e.g.*, Par. [0034], [0036], [0037] and FIG. 2). For each of the contacts, one or more telephony-related reportable events associated with the contact is choosed, whereby the reportable events for each contact may differ (*see e.g.*, Par. [0040], [0043], (202) of FIG. 2, (300) of FIG. 3, [0058]-[0059] and FIG. 6). Receiving a message alert instantaneously upon occurrence of the telephony-related reportable event and transmitted unbeknownst to the contact (*see e.g.*, Par. [0045], [0046] and FIG. 4). Viewing the alert comprising an informational message and a call-control option, both pertaining to a real-time status of one of the contacts and selecting the call-control option to initiate a telephony-related function to the contact. (*see e.g.*, Par. [0061]-[0065] and FIG. 7; [0047]-[0054] and FIGs. 5A-5H).

The subject matter of Independent Claim 14 is directed towards a method for status notification in a telecommunications network comprising a plurality of endpoints. The method begins with detecting a change in status of a monitored endpoint and determining if the change is an identified reportable event for the monitored endpoint (*see e.g.*, Par. [0061], [0062], (702) and

(710) of FIG. 7). If the change is the identified reportable event, then immediately transmitting a status alert to a user, unbeknownst to the monitored endpoint, requesting notification of the identified reportable event (*see e.g.*, Par. [0063] and (715) of FIG. 7). Transmitting simultaneous with the status alert, one or more viewable call processing commands related to the identified reportable event and the monitored endpoint (*see e.g.*, Par. [0063], [0064] and (715), (730) of FIG. 7). Processing the call command associated with the monitored endpoint (*see e.g.*, Par. [0064] and (735) of FIG. 7).

These claims provide a system and methods for endpoint status notification in a telecommunications network. A user of the network selects a personal list of contacts from an address book having the network user's names and their associated endpoints. The selected list is personal to the user and includes the contacts he wishes to receive status notifications on as well as the reportable events for each contact, whereby the reportable events can differ for each contact. Upon every occurrence of a reportable event pertaining to one of the contacts, the system sends an instant message alert to the user unbeknownst to the contact. Simultaneous with the instant message alert, the system sends a call-control option and, if selected by the user, causes a telecommunication function related to the reportable event and pertaining to the contact to immediately occur (*see e.g.*, Par. [0008]).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL.

The only issue for consideration on this Appeal is (A) Whether Applicant's claims are anticipated by the Mullaly reference under 35 USC §102(a).

VII. ARGUMENT.

A. APPELLANT'S CLAIMS ARE NOT ANTICIPATED BY MULLALY

LEGAL STANDARD

MPEP 2131 and 35 USC §102

Prima facie anticipation under 35 U.S.C. § 102 is established only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Veregall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

As is well-established, in order to establish a *prima facie* case of anticipation, the cited prior art must teach or suggest every limitation of the claims being rejected. Therefore, if even one claim element or limitation is missing from the cited prior art, a *prima facie* case is not established.

ARGUMENT

All claims stand finally rejected under 35 USC § 102(a) as being anticipated by U.S. Patent 6,553,341 to Mullaly et al ("Mullaly"). For the reasons that follow, Appellant respectfully requests this rejection be overturned.

It is respectfully asserted that, as one example, Mullaly fails to disclose a viewable call-control option received simultaneous with the alert. Applicant discloses and claims a "viewable call-control option" that is received "simultaneously with the alert." As specifically set forth in Applicant's specification, "a call control option" is provided to the user so that the user can immediately respond to the message alert with a telecommunication function related to the event. For example, Figures 5A and 5B from Applicant's specification are shown below. The exemplary pop-up alert 5A displays the informational status message pertaining to the contact ("Sheila Brown's status has changed to available") and includes a viewable call control option delivered simultaneous with the message alert ("call"). When activated by the user, the hotspot "call" immediately places a call from the user to Sheila Brown's extension or number. The exemplary pop-up alert 5B may appear immediately after the user selects the call control option. Now the user is provided with a different informational status message ("Calling Sheila Brown at 21352") and includes different call control options pertinent to the current alert ("Hangup", "Leave Message", "Send to Voicemail"). Again, the user has the option to select one of the call control options to cause the telecommunication function to occur.

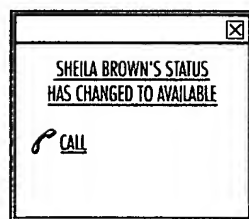


Fig. 5A

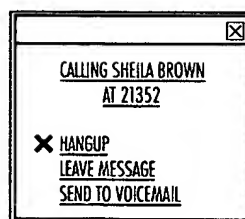


Fig. 5B

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In contrast to Applicant's disclosure and claims, Mullaly is a system for announcing the receipt of an email message, *such as by synthesized speech*. The problem Mullaly attempts to correct is to prevent important email messages from being missed until it is possibly too late to respond to them. Mullaly states that because of the large amounts of email sent between users, often times a user will check his mailbox and find a multitude of new email that has arrived since the last time the user checked his box. This situation can result in important messages being ignored or unseen. Thus, Mullaly states that "*It is desirable for an arrival of the new email with the desired information to be announced in an audible fashion*". Mullaly discloses an audible notification using text to speech technology to announce various details of the email message. For instance, a user may select or customize announcements using natural language sentences, phrases, or anything that the user may desire. For example, Mullaly discloses that an audible announcement to the user may be, "Excuse me, Steve Daniel's has just sent you mail about the plant trip", where "Steve Daniel's" and "plant trip" are parsed and extracted from a note from Steve Daniel's and combined with surrounding text to form an appropriate and informative announcement. In this manner, the announcement audibly informs the user of the content of the message so the user does not miss an important message, and the user is better informed about the information received without having to shift from their current task.

The Final Action points to Mullaly column 2, lines 36-43 for support of "an instant message alert" as claimed by Applicant. Referring to the selected Mullaly passage, when a message including text is received, the message is filtered to determine *what will be announced*.

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Text from the filtered message is selectively combined with announcement text to create modified announcement text in which filtered text is selectively placed into the announcement text. The modified announcement text is then transformed into synthesized speech or combined synthesized speech with prerecorded audio. As can be seen from the above passage, the Mullaly "alert" is clearly an audible announcement of the receipt of an email message and the message text is filtered and transformed into speech. Mullaly fails to disclose a viewable call-control option received simultaneous with the alert.

The Final Action points to Mullaly column 8, lines 3-13 and Figure 8 for support of "a viewable call-control option received by said one user simultaneous with the instant message alert and selection of said option causes a telecommunication function related to the reportable event and pertaining to the contact to immediately occur" as claimed by the Applicant. Referring to the selected Mullaly passage, as well as the text immediately preceding and following the passage, when email messages are received they are listed in a GUI. Mullaly GUI 600 illustrates a listing of messages received by the user over a specified period of time. The user may select one of the entries to display the entire message and may send mail by selecting a mail button. "Sending mail" is referring to sending an email message to a contact and this not similar to selecting a "call-control option" as disclosed and claimed by Applicant. Additionally, for the user to actually "send mail" from the GUI, the user must first select one of the entries from the compiled list of received messages, view the particular message and then select "send mail". This operation is not akin to Applicant's status notification system whereby a message alert is

received (e.g., Fig. 5A) comprising a viewable informational status message pertaining to the contract and a viewable call-control option received simultaneous with the message alert. Furthermore, the “send mail” option is not available simultaneous with the Mullaly message alert, but rather is available from a list *after the Mullaly message was received*. Mullaly Figure 8 and accompanying passages further describes a GUI 800 for customizing notification settings. GUI 800 includes a visual notification option that when selected, brings the window containing the list of messages to the top. This window is a GUI, such as GUI 600 described above. Again, the GUIs disclosed by Mullaly are for parsing and viewing a list of messages *after they have been received and catalogued, not simultaneous with the alert*. Mullaly fails to disclose a viewable call-control option received simultaneous with the alert.

The Final Action includes a Response to Applicant's Arguments and states that Mullaly discloses a viewable call-control option received simultaneous with the alert at least at Mullaly column 7, lines 20-41. Referring to the selected passage, a GUI 502 provides an appropriate display of received messages including the type of messages. This is not akin to a viewable call-control option received simultaneous with the alert as recited by Applicant's claims.

The Response to Applicant's Arguments of the Final Action further states Applicant's arguments of a disclosed “call control option” are not persuasive since limitations from the specification are not read into the claims. Applicant is not asking for limitations from the specification to be considered, only the limitations present in the claims. Claim 1 recites that “a viewable call-control option received by said one user simultaneous with the instant message

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alert and selection of said option causes a telecommunication function related to the reportable event and pertaining to the contact to immediately occur.” Claim 9 recites “viewing the alert comprising an informational message and a call-control option, both pertaining to a real-time status of one of the contacts, and selecting the call-control option to initiate a telephony-related function to the contact.” Therefore, it is clearly stated that the “call-control option” causes a telecommunication or telephony-related function to occur. Additionally, the telecommunication or telephony-related function pertains to a contact.

Finally in the Response to Applicant's Arguments of the Final Action, it states that features upon which Applicant relies as not being found in the Mullaly reference are not recited in Applicant's claims. Specifically, the Action states that “displays the informational status message pertaining to the contact” is not in the claims. Applicant respectfully disagrees. Claim 1 recites that “the alert comprising one of a plurality of viewable informational status messages pertaining to the contact.” Claim 9 recites “viewing the alert comprising an informational message and a call-control option, both pertaining to a real-time status of one of the contacts.” Therefore, it is clearly understood that the “informational status message pertaining to the contact” is viewable and thus must be displayed.

VIII. CONCLUSION.

It is respectfully submitted that in view of the foregoing all of the pending claims are patentable over the cited prior art and the Board is respectfully requested to overturn the rejections of record and allow this application to issue.

IX. CLAIMS APPENDIX.

A claims Appendix A containing a copy of claims subject to this appeal is attached.

X. EVIDENCE APPENDIX.

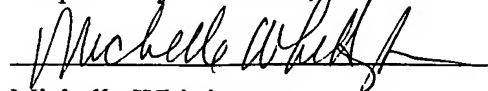
None submitted.

XI. RELATED PROCEEDINGS APPENDIX

None (no related proceedings).

The Commissioner is hereby authorized to charge any additional fees and credit any overpayment associated with this Appeal to Inter-Tel Deposit Account No. 502721.

Respectfully submitted,



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Inter-Tel (Delaware), Inc.

Date: June 19, 2008

APPENDIX A CLAIMS

Claim 1 (previously presented):

An endpoint status notification system for use in a telecommunications network, the system comprising:

- an address book comprising a plurality of network user's names and their associated endpoints;

- a personal list of contacts comprising the users selected from the address book by one of the users;

- an instant message alert received by said one user upon every occurrence of a reportable event for the contacts on the list, the alert comprising one of a plurality of viewable informational status messages pertaining to the contact and delivered to said one user unbeknownst to the contact, the reportable event being selected by said one user for each of the contacts on the list, whereby the reportable events received by said one user may differ for each of the contacts on the personal list; and

- a viewable call-control option received by said one user simultaneous with the instant message alert and selection of said option causes a telecommunication function related to the reportable event and pertaining to the contact to immediately occur.

Claim 2 (original): The system of claim 1, wherein said instant message alert comprises a popup window on a display of an endpoint of said one user.

Claim 3 (cancelled).

Claim 4 (original): The system of claim 1, wherein one of the contacts on the personal list comprises said one user, thereby said one user receiving the instant message alert for every occurrence of a reportable event for said one user.

Claim 5 (original): The system of claim 1, wherein the instant message alert is received for a preset amount of time to be determined by said one user.

Claim 6 (original): The system of claim 1 further comprising a log of the reportable events for said one user and viewable by said one user sometime after the event occurs.

Claim 7 (original): The system of claim 1, wherein the personal list of contacts further comprises a textual display of a current status of the contacts, the list being viewable by said one user and updated immediately following a reportable event, whereby said one user is able to view a real-time status of the contacts.

Claim 8 (original): The system of claim 1, wherein said one user proxies another user to receive the instant message alerts intended for said one user.

Claim 9 (original): A method of endpoint status notification system in a telecommunications network comprising a plurality of users, the method comprising:

- selecting a list of personal contacts from an address book comprising names and endpoints belonging to the users;

- for each of the contacts, choosing one or more telephony-related reportable events associated with the contact, whereby the reportable events for each contact may differ;

- receiving a message alert instantaneously upon occurrence of the telephony-related reportable event and transmitted unbeknownst to the contact;

- viewing the alert comprising an informational message and a call-control option, both pertaining to a real-time status of one of the contacts;

- selecting the call-control option to initiate a telephony-related function to the contact.

Claim 10 (cancelled).

Claim 11 (original): The method of claim 9, wherein viewing the alert comprises viewing a popup window for a pre-determined time limit.

Claim 12 (original): The method of claim 9 further comprising viewing a menu of telephony-related reportable events for each contact prior to choosing the reportable events.

Claim 13 (original): The method of claim 12 further comprising viewing the list of personal contacts and a real-time status of each contact displayed near each name.

Claim 14 (previously presented):

A method for status notification in a telecommunications network comprising a plurality of endpoints, the method comprising:

- detecting a change in status of a monitored endpoint;

- determining if the change is an identified reportable event for the monitored endpoint;

- if the change is the identified reportable event, then immediately transmitting a status alert to a user, unbeknownst to the monitored endpoint, requesting notification of the identified reportable event;

- transmitting, simultaneous with the status alert, one or more viewable call processing commands related to the identified reportable event and the monitored endpoint; and

- processing the call command associated with the monitored endpoint.

Claim 15 (original): The method of claim 14, wherein determining comprises comparing the change to a pre-selected and stored reportable event for the monitored endpoint.

Claim 16 (original): The method of claim 14, wherein transmitting a status alert comprises transmitting and displaying a popup window.

Claim 17 (original): The method of claim 14, further comprising causing an audible alert to indicate the identified reportable event.

Claim 18 (original): The method of claim 14, wherein reportable events vary for each monitored endpoint.